UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,085	01/18/2001	Tomoshi Hirayama	204685US6	6133

			EXAMINER
22850	7590	01/06/2006	VU, NGOC K

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ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 December 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>24-33 and 37-53</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>24-33 and 37-53</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____.

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413)
                                                               Paper No(s)/Mail Date. _____ .
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)   6)☐ Other: _____ .
     Paper No(s)/Mail Date _____ .

Allowable Subject Matter

1.   The indicated allowability of claims 24-33 and 37-53 is withdrawn in view of the

reference(s) to Picco and Hendricks. Rejections based on these reference(s) are addressed

below.

Claim Objections

2.   Claims 24 and 44 are objected to because of the following informalities: it appears that

the limitation "the terminal ID information" is not previously defined. Accordingly, please change

the limitation "the terminal ID information" into "terminal ID information". Appropriate correction

is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 37-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant regards

as the invention.

Claim 37 is indefinite because there is no antecedent basis for the limitation "said

terminal section" in line 8. Appropriate correction is required.

Claim 38 is indefinite because there is no antecedent basis for the limitation "the

revision" in line 7. Appropriate correction is required.

Claim 39 is indefinite because there is no antecedent basis for the limitation "the

assisting materials" in line 6. It seems to appear that the term "the assisting materials" refers to

"the auxiliary materials" as previously recited in the claim. For examining purpose, examiner

considers the limitation "the assisting materials" in line 6 to be "auxiliary materials". Appropriate

correction is required.

Claim 44 is indefinite because there is no antecedent basis for the limitation "said

transmission server section" in line 10. Appropriate correction is required.

Claim 49 is indefinite because there is no antecedent basis for the limitation "the

assisting materials" in line 6. It seems to appear that the term "the assisting materials" refers to

"the auxiliary materials" as previously recited in the claim. For examining purpose, examiner

considers the limitation "the assisting materials" in line 6 to be "auxiliary materials". Appropriate

correction is required.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 24-33 and 37-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Picco et al. (US 6,029,045 A) in view of Hendricks et al. (US 6,463,585 B1).

Regarding claim 24, Picco teaches an information providing system (see figure 4)

comprising:

a transmission server session (144) configured to transmit a continuous stream (data

stream) of contents data of a group of multimedia contents including prearranged combinations

of program main body data (programming data) prepared with sorting information (viewing

statistics or viewing history data about the television programs and local contents) annexed

thereto and groups of auxiliary materials (local contents) (It is noted that the programming data

and local contents prepared with the viewing statistics or viewing history data are multiplexed

into a compressed digital data stream), the auxiliary materials including at least commercial data

(advertisements) with attributes (content profile) including at least an effective date (the content profile include a time of day the coal content may be viewed) (see col. 6, lines 46-50; col. 6, line 59 -67; col. 7, lines 24-32);

terminal sessions (120) having a function of receiving the continuous stream of contents data transmitted from said transmission server session, a function of recording the program main body data and the auxiliary materials received by it (storing the received programming data and local contents), a function of recording the sorting information annexed to said program main body data and said auxiliary materials (recording the viewing history data at a household) and a function of transmitting the sorting information annexed to the program main body data and the auxiliary materials selected by it (transmitting the viewing history data to agent 150) (see col. 7, lines 12-24); and

a processing server section (150) configured to detect any change to be made to the auxiliary materials combined with the selected program main body data and, upon detecting such a change, issuing an instruction for the change made to be made to said auxiliary materials to the related terminal section (for instance, if the viewing statistics for a particular household changes based on the viewing history data gathered by the agent 150, a scheduler may generate an instruction which instructs a set-top box to store a different set of the local content that is also being transmitted to the household – see col. 7, lines 35-41).

Picco does not specifically disclose the terminal sessions having a function of transmitting the terminal ID information. However, Hendricks discloses that a set top terminal 220 transmits information including history data and the unique set top terminal identification information to a headend or national site (see col. 28, lines 20-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Picco by transmitting the terminal ID information with history data from a set top box

as suggested by Hendricks in order to allow the headend to easily track viewing history of the identified set top box.

Regarding claim 25, Picco teaches that the terminal sections have a function of receiving the instruction for the change to be made to the auxiliary materials from said processing server section (see col. 7, lines 35-41). Picco does not teach sending back the conditions for the instruction for the change and an acknowledgement or refusal of the change. Official Notice is taken that it is well known in the art that a device may generate an acknowledgement or failure message and the conditions thereof in response to an instruction. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Picco with the terminal response of the well-known prior art in order inform the server that a particular storage request can or cannot be fulfilled and the condition, for example, it the terminal's hard disk drive were full, such that the server would know to try the request again later or to issue a delete command to free up space.

Regarding claims 26-27, Picco teaches that the terminal sections have a function of receiving the instruction for the change to be made to the auxiliary materials from said processing server section (see col. 7, lines 35-41) and recording (storing) the instruction for the change before starting the reproduction of the materials or reediting the contents data (updating the stored information) according to the instruction for the change (see col. 7, lines 38-40).

Regarding claim 28, the combined system of Picco and Hendricks teaches that upon detecting the existence of revision assisting materials (a different set of local contents) for the auxiliary materials combined with the program main body data selected by said information terminal according to the sorting information (viewing statistics and/or viewing history data) and the terminal ID information (the unique set top terminal identification information) transmitted from said information terminal, said information server section notifies said terminal section of

the existence of revision assisting materials and, upon receiving an acknowledgment for

reception (it must be understood that the server would not send the local contents to the

terminal without receiving an acknowledgement for reception), sends out the revision assisting

materials and the instruction for the revision to said terminal section (see Picco: col. 7, lines 35-

48; Hendricks: col. 28, lines 20-25).

Regarding claim 29, the combined system of Picco and Hendricks teaches that upon

detecting any auxiliary materials (local data) to be added the auxiliary materials (local contents)

combined with the program main body data (programming data) selected by said information

terminal according to the sorting information (viewing statistics or viewing history data) and the

terminal ID information (the unique set top terminal identification information) transmitted from

said information terminal, said information server section notifies said terminal section of the

auxiliary materials to be added and, upon receiving an acknowledgment for reception (it must be

understood that the server would not send the local data to the terminal without receiving an

acknowledgement for reception), sends out the auxiliary materials to be added and the

instruction for the revision to said terminal section (see Picco: col. 7, lines 35-48; Hendricks: col.

28, lines 20-25).

Regarding claim 30, the combined system of Picco and Hendricks teaches that particular

pieces of local content may be filtered out upon detecting the command and control data from

the provider. It is further noted the provider provides the local contents based on the viewing

statistics and/or viewing history data (see Picco: col. 10, lines 18-22; Hendricks: col. 28, lines

20-25).

Regarding claim 31, the combined system of Picco and Hendricks teaches that an

operation of adding up the contents reproduced at said information terminal according to the

sorting information (see Picco: col. 9-10, lines 65-4) and the terminal ID information transmitted from said information terminal (see Hendricks: col. 28, lines 20-25).

Regarding claim 32, the combined system of Picco and Hendricks teaches that an operation of confirming the copying status of the contents reproduced at said information terminal according to the sorting information (via upload of statistics from the household – see Picco: col. 7, lines 41-45) and the terminal ID information transmitted from said information terminal (see Hendricks: col. 28, lines 20-25).

Regarding claim 33, Picco further teaches that an account settlement means for adding up the instructions for changes to be made to the auxiliary materials issued from said processing server session to said terminal section and settling the account according to the result of the adding up operation (updating a local content control block and requesting an upload of the viewing statistics or collecting user data – see col. 7, lines 41-45).

Regarding claim 37, Picco teaches an information server device (102 – see figure 4) having:

a function of receiving sorting information (viewing history information or viewing statistics) from an information terminal (120) having a function of transmitting said sorting information as annexed to selected program main body data (programming data) and auxiliary materials (local contents), the auxiliary materials including at least commercial data (advertisements) with attributes (content profile) including at least an effective date (the content profile include a time of day the coal content may be viewed) (see col. 7, lines 4-23; col. 6, lines 59-67);

a function of detecting any change to be made to the auxiliary materials combined with the selected program main body data by the terminal section on the basis of sorting information (based on viewing history information or viewing statistics) (see col. 7, lines 35-37);

a function of issuing an instruction for the change made to be made to said auxiliary materials to the related terminal section (for instance, if the viewing statistics for a particular household changes based on the viewing history data gathered by the agent 150, a scheduler may generate an instruction which instructs a set-top box to store a different set of the local content that is also being transmitted to the household – see col. 7, lines 35-41).

Picco does not specifically disclose the terminal sessions having a function of transmitting the terminal ID information. However, Hendricks discloses that a set top terminal 220 transmits information including history data and the unique set top terminal identification information to a headend or national site (see col. 28, lines 20-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Picco by transmitting the terminal ID information with history data from a set top box as suggested by Hendricks in order to allow the headend to easily track viewing history of the identified set top box.

Claims 38-43 recite the similar limitations of claims 28-33, respectively. Accordingly, claims 38-43 are rejected for the same reasons as addressed above. See rejections of claims 28-33.

Claim 44 recites an information providing method comprising similar limitations of claim 24. Claims 45-53 recite the similar limitations of claims 25-33, respectively. Accordingly, claims 44-53 are rejected for the same reasons as addressed above. See rejections of claims 24-33.

Conclusion

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ngoc K. Vu
Primary Examiner
Art Unit 2611

January 2, 2006